

### **REMARKS**

This amendment is responsive to the Office Action dated July 25, 2005. Applicant has amended claims 62, 66, 68, and 70, and added new claim 73. Claims 49–73 are pending.

#### **Claim Rejection Under 35 U.S.C. § 112**

In the Office Action, the Examiner rejected claim 66 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 66 to insert the word “of.” Applicant thanks the Examiner for identifying the typographical error. Applicant has also amended claim 68 to address the formalities identified by the Examiner.

The Examiner also rejected claims 49–71 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses the rejection. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can *reasonably conclude* that the inventor had possession of the claimed invention.<sup>1</sup> With respect to newly added claims, i.e., claims not found in the original disclosure, claim limitations can be satisfied through express, implicit or even inherent disclosure.<sup>2</sup>

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.<sup>3</sup> Moreover, the examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an Appellant’s disclosure a description of the invention defined by the claims.<sup>4</sup> In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. The Examiner must: (A) identify the claim limitation at issue; and (B) establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application

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<sup>1</sup> See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

<sup>2</sup> See MPEP 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, “Written Description” Requirement, pg. 5.

<sup>3</sup> See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971)

<sup>4</sup> *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.<sup>5</sup>

Before addressing claims 49–71, Appellant notes that in the present Office Action, the Examiner made nothing more than a general allegation that she was unable to find support for certain claim elements. This general statement alone is insufficient to establish a prima facie case by presenting a preponderance of evidence. Appellant now addresses specific requirements of claims 49–71 identified by the Examiner.

*Claims 49 and 58*

With respect to claims 49 and 58, the Examiner first asserted that she was unable to find support for the limitation of “wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace.” The Examiner then asserted that she was unable to find support for the limitation of “electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute.” Finally, the Examiner asserted that she was unable to find support for “utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.”

Contrary to the Examiner’s assertions, these elements are supported throughout the present application. As a starting point, FIG. 1 shows a marketplace 102 separate from dispute resolution system 130. The present application describes an “online marketplace” as “a website or an online centralized trading place.”<sup>6</sup> The present application gives a specific example of an online marketplace as www.eBay.com, which is a well-known centralized trading place.<sup>7</sup> Thus, the present application makes clear that the online marketplace is a system that provides a centralized trading place, and is not an individual buyer or seller.

FIG. 2B shows a “second implementation” 150 of the invention in which the dispute resolution system integrates with a business partner’s system, such as the online marketplace 102. The totality of the description of FIG. 2B makes clear that marketplace 102 of FIG. 1 is one

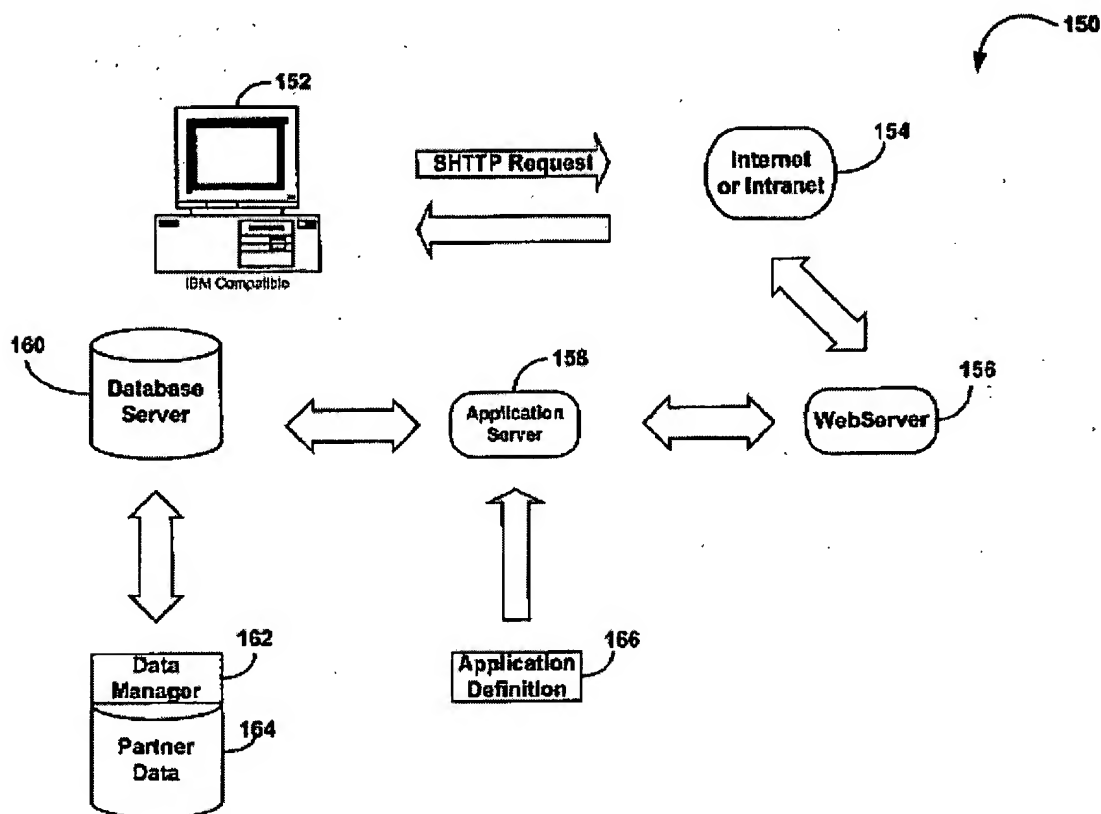
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<sup>5</sup> See MPEP 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, “Written Description” Requirement, pg. 18.

<sup>6</sup> Present application at 0039.

<sup>7</sup> Present application at 0040.

example of a partner system referred to in FIG. 2B. For example, as discussed below, the functionality of FIG. 2B is described in the present application in reference to buyers and sellers of the online marketplace by way of example.<sup>8</sup>



**FIG. 2B**

With respect to the second embodiment 150, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” Paragraphs [0045]–[0049] of the application also describe a server 158 of dispute resolution system 150 as receiving data from a set of remote software objects that execute within the partner’s system 166. At paragraph [0047], the present application specifically states that example functionality includes the remote software objects as informing the dispute resolution system 130 of relevant “partner transactions.”

This clearly establishes that the inventors were in possession of the concept that online marketplace 102 of FIG. 1 has a separate database (a “partner database” 164) that stores “partner

<sup>8</sup> See, e.g., para. [0074]–[0048] (describing Example functionality includes informing the dispute resolution system 130 of relevant partner transactions and allowing partners to query the dispute resolution system data such as the status of a specific marketplace seller 104) (emphasis added).

transactions.” The term “transactions” is used extensively to refer to transactions within marketplace 102 involving buyers and sellers.<sup>9</sup> Further, the present application provides numerous examples of dispute resolution system 130 as utilizing data describing the transaction to assist buyers and sellers in resolving the disputes related to those transactions. As one example, FIG. 10 shows “a predictive reasoning process 500” in which the dispute resolution system 130 utilizes data describing a disputed transaction to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”<sup>10</sup> In this example, the specification makes clear that dispute resolution system 130 uses data describing the transaction to search a historical database to identify previous cases with similar facts. Dispute resolution system 130 then retrieves and summarizes and displays the outcomes of the cases similar to the disputed transaction for all parties and the dispute resolution specialist to assist them in resolving the present dispute.

For at least these reasons, it is without dispute that a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claimed limitation that the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace. Moreover, it is equally without dispute that a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claimed limitation of electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute. Finally, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claimed limitation of utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace. The Examiner’s unsupported allegation does not overcome this substantial evidence.

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<sup>9</sup> See, e.g., paras. [0039]–[0041], describing buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions.

<sup>10</sup> Para. [0085].

*Claim 52*

With respect to claim 52, the Examiner asserted that she was unable to find support for the limitation of “wherein the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” At paragraph [0048], the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn *communicates with one or more partner databases 164.*” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to query the dispute resolution system data such as the status of a specific marketplace seller 104. This makes clear that the software objects executing on the marketplace system or any other partner system may electronically query (via SQL or other format) online dispute resolution system 130, receiving status of specific marketplace sellers 104 in response to that query and updating partner databases 164.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace, as required by claim 52.

*Claim 53*

With respect to claim 53, the Examiner asserted that she was unable to find support for the limitation of “a server to service electronic requests issued by a server within the electronic marketplace and to exchange data between the online dispute resolution system and the electronic marketplace.”

As discussed above, paragraph [0048] of the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn communicates with one or more partner databases 164.” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to inform the online dispute resolution

system of transactions at the marketplace (thus communicating data from the marketplace 102 to the online dispute resolution system 130) as well as functionality to query the dispute resolution system 130 data and receive data in return. This makes clear that in the described second implementation data can be communicated in both directions between marketplace 102 and online dispute resolution system 130, e.g., data from the partner system to the online dispute resolution system 130 to inform the dispute resolution system of transactions, and status data from the online dispute resolution system 130 back to the partner system.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system includes a server (e.g., SQL server 160) to service electronic requests (e.g., queries) issued by a server within the electronic marketplace and to exchange data (e.g., partner data and status information) between the online dispute resolution system and the electronic marketplace, as required by claim 53.

*Claim 54*

With respect to claim 54, the Examiner asserted that she was unable to find support for the limitation of “a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” Further, paragraph [0048] of the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 (shown as a “database server 160” in FIG. 2B) of the dispute resolution system 150 communicates with a **data manager 162**, which “in turn communicates with one or more partner databases 164.”

Moreover, the present application makes clear that these software objects executing at the partner system (e.g., the marketplace) interact with data manager 162 to provide functionality to automatically send and receive specific information to and from the dispute resolution system 130. According to the present application, the objects will “transparently deal with communication issues.”<sup>11</sup> This makes clear that the software objects transparently handle

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<sup>11</sup> Para. [0047].

communication of the partner data from the partner system to the online dispute resolution system 130.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system include a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace, as required by claim 54.

*Claim 55*

With respect to claim 55, the Examiner asserted that she was unable to find support for the limitation of “wherein the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” At paragraph [0048], the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn communicates with one or more partner databases 164.” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to query the dispute resolution system data such as the status of a specific marketplace seller 104. This makes clear that the software objects executing on the marketplace system or any other partner system may electronically query (via SQL or other format) online dispute resolution system 130 and in return receive status of specific marketplace sellers 104. The present application describes one example of data maintained by the online dispute resolution system as data that relates to the “participation in the dispute resolution process, or can relate to compliance of a participant to the final decision made in the resolution of the dispute.”<sup>12</sup>

It would be apparent to a person skilled in the art that, in view of the totality of Applicant’s teachings, that the data related to the participation of the seller or compliance with a final decision is one type of data that could be automatically communicated to the marketplace

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<sup>12</sup> Para. [0011].

via data manager 162, possibly in response to the described queries via the remote software objects executing with the partner's system. Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace, as required by claim 55.

*Claims 51 and 60*

With respect to claims 51 and 60, the Examiner asserted that she was unable to find support for the limitation that the online dispute resolution system "electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system."

As one example of support for this limitation, Fig. 4 is a diagram illustrating a process 240 executed by the dispute resolution system whereby a seller can request coverage from the dispute resolution system. Block 240 of FIG. 4 clearly shows the request being initiated at the *partner system* (see block 240 of FIG. 4). Upon receipt of a request to initiate coverage from the partner system, the online dispute system 130 of Fig. 1 provides the seller with a welcome page 242 wherein the seller can complete the registration process. Blocks 248 and 250 show links for returning the seller to the partner site (see, e.g., hyperlinks of "Back to Partner" and "List of Partner Sites").

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system, as required by claim 60.

*Claim 61*

With respect to claim 61, the Examiner asserted that she was unable to find support for the limitations of "electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace, and updating the electronic marketplace based on the data received from the dispute resolution system."



For reasons set forth above, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation of electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace. Support for this element has been demonstrated above.

With respect to the limitation of updating the electronic marketplace based on the data received from the dispute resolution system, the present application describes a registration process in which the online dispute resolution system 130 updates a membership profile database, notifies the applicant of acceptance, and sends electronic data (indicia) to be displayed on the seller's point of sale to indicate membership in the dispute resolution process.<sup>13</sup> Thus, the present application makes clear that the online dispute resolution system is capable of executing a process that sends electronic data to be displayed within a partner system to indicate membership of a particular seller. Moreover, claim 53 as originally filed in the parent application Serial No. 09/504,159, filed February 15, 2000, requires a system, comprising: a network; an electronic marketplace coupled to the network; one or more sellers selling one or more items at the marketplace; one or more buyers consuming one or more items at the marketplace; and a dispute resolution system coupled to the network to resolve a dispute between one or more buyer and seller parties, wherein the dispute resolution system provides a visual indicia to indicate membership in the dispute resolution process. For at least these reasons, a person skilled in the art at the time the application was filed would have recognized that the inventors were in possession of the claim limitation of updating the electronic marketplace based on the data received from the dispute resolution system, as required by claim 61.

*Claim 62*

With respect to claim 62, the Examiner asserted that she was unable to find support for the limitations of “automatically” controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes. Although Applicant disagrees, the Applicant has amended claim 62 to delete the term “automatically.”

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<sup>13</sup> Para. [0053].

*Claim 63*

With respect to claim 63, the Examiner asserted that she was unable to find support for the limitations of “embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website of the electronic marketplace to enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and file disputes without manually entering the transaction data into the dispute resolution system.” In particular, the Examiner appears to assert that she could not support for accessing the dispute resolution system from a website of an electronic marketplace and file disputes *without manually entering the transaction data into the dispute resolution system*.

As described in detail above, the present application describes a second embodiment 150 that describes the online dispute resolution system 130 as having a server 158 that “receives data from a set of remote software objects that execute within the partner’s system 166.”<sup>14</sup> At paragraph [0047], the present application specifically states that example functionality includes the remote software objects as informing the dispute resolution system 130 of relevant “partner transactions.” This clearly establishes that the inventors were in possession of the concept that online marketplace 102 of FIG. 1 (described as an example partner system) utilizes software objects to communicate data to server 150 of online dispute resolution 130 to describe “partner transactions.” The term “transactions” is used extensively to refer to transactions within marketplace 102 involving buyers and sellers.<sup>15</sup> These sections makes clear that the inventor contemplated the remote software objects of the partner system actually communicating data from the database (partner database 164) of the marketplace to the database (SQL server 160) of the online dispute resolution system.

Moreover, the present application makes clear that these software objects executing at the partner system (e.g., the marketplace) interact with data manager 162 to provide functionality to automatically send and receive specific information to and from the dispute resolution system 130. For example, according to the present application, the remote software objects of the partner system will “transparently deal with communication issues” including server

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<sup>14</sup> Paras. [0045]–[0049].

<sup>15</sup> See, e.g., paras. [0039]–[0041], describing buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions.

unavailability and performance when communicating data to the database of online dispute resolution system 130.<sup>16</sup> These sections makes clear that the software objects *transparently* communicate the partner data from the partner system to the online dispute resolution system 130. Thus, although the specification does not include the exact words “without manually entering the transaction data into the dispute resolution system,” it is clear that the present inventors contemplated and described *transparent* electronic transfer of *transactions* from the database 164 of the marketplace 102 to the database 160 of the online dispute resolution system. Applicants remind the Examiner that claim limitations can be satisfied through express, *implicit* or even *inherent* disclosure.<sup>17</sup>

For at least these reasons, one skilled in the art would reasonably conclude that the Appellant was in possession of the claimed subject matter of accessing the dispute resolution system from a website of an electronic marketplace and file disputes *without manually entering the transaction data into the dispute resolution system*. It is clear that the inventors contemplated the remote software objects access database 164 of the marketplace 102 and *transparently* communicated to a database (SQL server 160) of online dispute system by way of remote data manager 162 to inform the dispute resolution system of transactions within the partner system. Thus, it is clear that the inventors contemplated at least one embodiment that would avoid manual entry of the transactions into the dispute resolution system 130. If indeed manual entry of transactions were always required, contrary to the second embodiment 150 of present application, then partner database 164 would not need to be accessed and server 156 would not “receive data” informing the online dispute resolution system 130 of “partner transactions,” as expressly stated by the present application.

#### *Claim 64*

With respect to claim 64, the Examiner questioned the claim limitation that the online dispute resolution system receive an electronic query from the marketplace. As explained above, the present application specifically describes a second implementation 150 in which remote software provide within the partner system functionality *to receive and send specific information*

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<sup>16</sup> Para. [0047].

<sup>17</sup> See MPEP 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, “Written Description” Requirement, pg. 5.

to the dispute resolution system 130.<sup>18</sup> Example functionality includes informing the dispute resolution system 130 of relevant partner transactions and allowing partner systems *to query* the dispute resolution system for data such as the status of a specific marketplace seller 104.<sup>19</sup>

#### *Claim 65*

With respect to claim 65, the Examiner questioned the claim limitation the electronic marketplace provide a status to the database of the electronic marketplace. As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” At paragraph [0048], the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 communicates with a data manager 162, which “in turn communicates with one or more *partner databases* 164.” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to *query* the dispute resolution system data such as the *status of a specific marketplace seller 104*. This makes clear that the inventors contemplated the software objects executing on the marketplace system or any other partner system may electronically querying (via SQL or other format) online dispute resolution system 130, receiving status of specific marketplace sellers 104 and updating partner databases 164.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace, as required by claim 65.

#### *Claims 67–72*

With respect to claims 67–72, the Examiner generally asserted that she was unable to find support for the following limitations:

(1) automatically communicating data from a database of the electronic marketplace to a database of the online dispute resolution system in response to a transaction within the electronic marketplace,

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<sup>18</sup> Paras. [0045]–[0049].

<sup>19</sup> Paras. [0045]–[0049].

(2) that the electronic marketplace stores transaction data that describes transactions within the marketplace and communicates the transaction data to the online dispute resolution system without human intervention,

(3) utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

These limitations have been thoroughly addressed above. As detailed, the present application describes a second embodiment 150 in which the online dispute resolution system 130 includes a server 158 that “receives data” from a set of remote software objects that execute within the partner’s system 166.”<sup>20</sup> At paragraph [0047], the present application specifically states that example functionality includes the remote software objects as informing the dispute resolution system 130 of relevant “partner transactions.” This clearly establishes that the inventors were in possession of the concept that online marketplace 102 of FIG. 1 (described as an example partner system) utilizes software objects to communicate data to server 150 of online dispute resolution 130 to describe “partner transactions.” The term “transactions” is used extensively to refer to transactions within marketplace 102 involving buyers and sellers.<sup>21</sup> These sections makes clear that the inventor contemplated the remote software objects of the partner system actually communicating data from the database (described as a partner database 164) of the marketplace to the database (described as a SQL server 160) of the online dispute resolution system to inform the system of transactions that have occurred within the marketplace.

Moreover, the present application makes clear that these software objects executing at the partner system (e.g., the marketplace) interact with data manager 162 to provide functionality to automatically send and receive specific information to and from the dispute resolution system 130. For example, according to the present application, the remote software objects of the partner system will “transparently deal with communication issues” including server unavailability and performance when communicating data to the database of online dispute resolution system 130.<sup>22</sup> These sections makes clear that the software objects *transparently* communicate the partner data from the partner system to the online dispute resolution system

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<sup>20</sup> Paras. [0045]–[0049].

<sup>21</sup> See, e.g., paras. [0039]–[0041], describing buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions.

<sup>22</sup> Para. [0047].

130. Thus, although the specification does not include the exact words “without manually entering the transaction data into the dispute resolution system,” it is clear that the present inventors contemplated and described *transparent* electronic transfer of *transactions* from the database 164 of the marketplace 102 to the database 160 of the online dispute resolution system. Again, Applicants remind the Examiner that claim limitations can be satisfied through express, *implicit* or even *inherent* disclosure.<sup>23</sup>

Further, the present application provides numerous examples of dispute resolution system 130 as utilizing data describing the transaction to assist buyers and sellers in resolving the disputes related to those transactions. As one example, FIG. 10 shows “a predictive reasoning process 500” in which the dispute resolution system 130 utilizes data describing a disputed transaction to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”<sup>24</sup> In this example, the specification makes clear that dispute resolution system 130 uses data describing the transaction to search a historical database to identify previous cases with similar facts. Dispute resolution system 130 then retrieves and summarizes and displays the outcomes of the cases similar to the disputed transaction for all parties and the dispute resolution specialist to assist them in resolving the present dispute.

For at least these reasons, one skilled in the art would reasonably conclude that the Appellant was in possession of the limitations of claims 67–72. It would be clear to one skilled in the art that the inventors were in possession of the claimed subject matter of automatically communicating data from a database of the electronic marketplace to a database of the online dispute resolution system in response to a transaction within the electronic marketplace. It is clear that the inventors contemplated the remote software objects access database 164 of the marketplace 102 and *transparently* communicated to a database (SQL server 160) of online dispute system by way of remote data manager 162 to inform the dispute resolution system of transactions within the partner system. Thus, it is clear that the inventors contemplated at least one embodiment that would avoid manual entry of the transactions into the dispute resolution system 130. Further, it is clear that the inventors were in possession of the limitation of utilizing

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<sup>23</sup> See MPEP 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, “Written Description” Requirement, pg. 5.

<sup>24</sup> Para. [0085].

the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

**Claim Rejection Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 49–61 and 64–72 under 35 U.S.C. 102(e) as being anticipated by Collins et al. (U.S. Publication No. 2002/0007362). Applicant respectfully traverses the rejection for the following reasons:

1. As discussed in Applicant's last response, the Examiner has erroneously relied on subject matter that does not qualify as prior art under 102(e).
2. Collins fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. 102(b), and provides no teaching that would have suggested the desirability of modification to include such features.

***Improper reliance on Figure 1B Collins***

In rejecting Applicants' claims, the Examiner repeatedly relied upon Figure 1B of Collins and the related disclosure of paragraph [0045]. In fact, the Examiner primarily relied upon Figure 1B and the related disclosure of Collins for each of Applicants' claims 49, 52–58, 64 and 66–72. However, this subject matter does not qualify as prior art under 102(e). Chapter 35 U.S.C. 102(e) states:

A person shall be entitled to a patent unless: ...

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ...

MPEP 2136.03 states that the 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application **if the provisional application(s) properly supports the subject matter relied upon** to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

Figure 1B and the related disclosure [0045] does not qualify as prior art with respect to the present application. The present application is a continuation of and claims priority to Serial No. 09/504,159, filed February 15, 2000. Collins was filed April 28, 2000, which is nearly two months after Applicant's priority date of February 15, 2000, but claims priority to three U.S. provisional applications filed prior to the priority date of the present application.

Figure 1A of Collins describes a first embodiment of a complaint-handling system and shows Party A and Party B interacting with a central server 120 of the complaint-handling system to negotiate an agreement. With respect to the embodiment of Figure 1A, Collins makes clear that the parties manually access the Collins's complaint handling system and manually enter all data describing a situation.<sup>25</sup>

Figure 1B of Collins describes an alternate embodiment in which Party B is a merchant and has a database that maintains records concerning customers. The maintained data may be number of transactions, amount of purchased merchandise, an associated rating or other data concerning the customer. The merchant database also stores a customer rating that may be provided to the complaint handling system to provide a mechanism for selecting a level that the customer should begin resolution.

However, the features of Figure 1B and the related description in paragraph [0045] are not taught or suggested by any of the priority documents of Collins. Applicant can find no teaching or mention within the priority documents relied upon by Collins of a merchant database at all. Moreover, none of the priority documents relied upon by Collins teach or describe use of customer rating data from a merchant database to select a level for beginning resolution or for any other purpose. Consequently, in accordance with MPEP 2136.03, with respect to the subject matter shown and described with respect to Figure 1B of the Collins reference does not receive the benefit of the filing dates of the priority documents. This disclosure of Collins formed the primary basis for the Examiner's rejection, and thus the rejection of claims 49–61 and 64–72 must be withdrawn.

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<sup>25</sup> Collins at [0037]-[0038] (stating that Party A "initiates a negotiation session by connecting with the central server 120 [of the complaint handling system] and providing data to the central server 120 concerning the nature of the situation and the identity of party B." Party B then responds by providing his or her position data to the same



***Failure to disclose each and every feature of the claimed invention***

Collins fails to teach or suggest each and every feature of the claimed invention.

***Claim 49***

Applicant's independent claim 49 is directed to a system as follows:

*A system comprising:*

*an online dispute resolution system electronically coupled to an electronic marketplace, wherein the electronic marketplace stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services,*

*wherein, in response to initiation of a dispute, the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data, and*

*wherein the dispute resolution system utilizes the received portion of the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.*

Similarly, Applicant's amended independent claim 58 is directed to a method as follows:

*A method comprising:*

*providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace;*

*electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute; and*

*utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.*

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system. With respect to the embodiment of Figure 1A, Collins describes Parties A and Parties B interacting with the

Contrary to claims 49 and 54, Collins does not teach or suggest a dispute resolution system in which a portion of transaction data stored within an electronic marketplace is received and used by the dispute resolution system without manual entry or intervention in response to initiation of a dispute. At least these features of claims 49 and 58 are not taught or suggested by Collins or any other reference of record, either singularly or in combination.

For example, Figure 1A of Collins describes a first embodiment of a complaint-handling system and shows Party A and Party B interacting with a central server 120 of the complaint-handling system to negotiate an agreement. With respect to the embodiment of Figure 1A, Collins makes clear that the parties manually access the Collins' complaint handling system and manually enter all data describing a situation. For example, at [0037]–[0038] Collins states that Party A “initiates a negotiation session by connecting with the central server 120 [of the complaint handling system] and providing data to the central server 120 concerning the nature of the situation and the identity of party B.” Party B then responds by providing his or her position data to the same system. With respect to the embodiment of Figure 1A, Collins describes Parties A and Parties B interacting with the central server 120 by interacting with HTML “templates.”<sup>26</sup> In other words, the parties utilize web browsers to directly interact with web pages provided by the complaint handling system to manually file a complaint and enter data describing their respective positions.

In rejecting claims 49 and 54, the Examiner refers primarily to Figure 1B and [0045] stating that Collins describes a merchant database maintaining records for customers and that the dispute may arise in connection over the Internet. First, as discussed above, this subject matter of Collins is not supported by any of the priority documents that predate Applicant's priority date and, therefore, this subject matter does not qualify as prior art.

Second, in addition to this error, Applicant points out that the single merchant database of Figure 1B is not an electronic marketplace that stores transaction data that describes transactions

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central server 120 by interacting with HTML “templates.”

<sup>26</sup> Collins at [0037]–[0038] (stating that Party A “initiates a negotiation session by connecting with the central server 120 [of the complaint handling system] and providing data to the central server 120 concerning the nature of the situation and the identity of party B.” Party B then responds by providing his or her position data to the same system. With respect to the embodiment of Figure 1A, Collins describes Parties A and Parties B interacting with the central server 120 by interacting with HTML “templates.”

within the electronic marketplace between buyers and sellers of goods or services, as required by claim 49. Applicant's claim 49 specifically requires that the claimed marketplace have both a plurality of "buyers" and a plurality of "sellers."

Third, neither [0045] nor any other portion of Collins actually describes transaction data being electronically communicated from an online marketplace to an online dispute resolution system. Paragraph [0045] of Collins only states that the Collins complaint handling system may utilize a "rating" of a customer as provided by a merchant's database. Collins does not describe actually communicating actual *transaction data* from a marketplace to a dispute resolution system to assist the parties in resolving a dispute.

Fourth, with respect to Applicant's claim requirement that the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data, the Examiner relies at least in part on the "computer program product" recited by Collins' claim 9. However, Collins' claim 9 specifically recites a computer program product having program code for "receiving position data from each of the plurality of parties over the network." Thus, the literal language of claim 9 of Collins relied upon by the Examiner contradicts her conclusion. The plain language of claim 9 of Collins states that the computer program receives position data from the parties, not from a database of an electronic marketplace. Collins' claim 9 has no teaching whatsoever that describes transaction data being electronically communicated from a database of a marketplace to a database of an online dispute resolution system. In fact, the only "database" mentioned in claim 9 is a "database containing resolutions." In other words, the only database even mentioned in claim 9 is the database of the dispute resolution system itself, not a database of a marketplace at all. Moreover, claim 9 makes clear that the parties provide "position data," and the database of the Collins complaint handling system stores "position data" provided manually by the parties. Thus claim 9 entirely void of any teaching of communicating transaction data between a database of an electronic marketplace and a database on an online dispute resolution system.

In summary, Figure 1B and [0045] does not qualify as prior art. Moreover, neither this portion nor any other portion of Collins teach or suggests an online dispute resolution system capable of electronically receiving at least a portion of the transaction data stored within the

electronic marketplace without requiring manual entry of the transaction data, as required by claim 49. Moreover, Collins fails to teach or suggest electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute, as required by claim 58.

For at least these reasons, the rejection of claims 49 and 58 is improper and should be withdrawn.

#### *Claim 52*

Applicant's claim 52 specifically requires that the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace. With respect to claim 52, the Examiner's entire argument is a single statement that Figure 1B and [0045] of Collins describes a merchant database storing an associated rating of the customer. This reasoning fails for at least four reasons.

First, as discussed above, this subject matter of Collins does not qualify as prior art.

Second, the "customer rating" described by Collins appears is a merchant's rating of the customer (e.g., based on sales volume), and is not a status maintained by the online dispute resolution at all.

Third, the Examiner has not addressed the literal requirement of claim 52 that status information is the online dispute resolution system is electronically communicated *to the electronic marketplace*. Collins describes the customer rating as already maintained by the merchant database, and the Examiner's passing reference to the merchant database completely overlooks the literal requirements of Applicant's claim 52. Contrary to claim 52, paragraph [0052] of Collins describes the rating data as being stored at a merchant database and then communicated in the opposite direction, i.e., from the merchant database to the Collins' complaint handling system. Applicants' claim requires an online dispute resolution having the novel ability to actually communicate status information back to the electronic marketplace. To the extent the single merchant database can even be considered a marketplace, Collins does not teach or suggest communicating status information from the online dispute resolution system to the online marketplace.

Fourth, as pointed out above, single merchant database of Figure 1B is not an electronic marketplace that stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services, as required by claim 52.

For at least these reasons, the rejection of claim 52 is improper and should be withdrawn.

*Claim 53*

Claim 53 requires that the online dispute resolution system further comprises a server to service electronic requests issued by a server within the electronic marketplace and to exchange data between the online dispute resolution system and the electronic marketplace.

In rejecting claim 53, the Examiner relies primarily to Figure 1B and [0045] and claim 9 of Collins. Again, the Examiner's rejection is erroneous for numerous reasons.

First, as discussed above, the subject matter Figure 1B and [0045] of Collins is not supported by any of the priority documents that predate Applicant's priority date and, therefore, does not qualify as prior art.

Second, the single merchant database of Figure 1B is not an electronic marketplace that stores transaction data that describes transactions within the electronic marketplace between a plurality of buyers and a plurality of sellers of goods or services, as required by claim 53.

Third, neither [0045], claim 9 nor any other portion of Collins actually describes a server to service electronic requests issued by a server within the electronic marketplace and to exchange data between the online dispute resolution system and the electronic marketplace. Paragraph [0045] of Collins only states that the Collins complaint handling system may utilize a "rating" of a customer as provided by a merchant's database. Claim 9 states that the computer program receives position data from the parties, not from a database of an electronic marketplace. Thus, none of the portions cited by the Examiner teach or even suggest an online dispute resolution system capable of servicing electronic requests issued by a server from an electronic marketplace.

In summary, Figure 1B and [0045] does not qualify as prior art. Moreover, neither this portion nor any other portion of Collins teaches or suggests an online dispute resolution system capable of servicing electronic requests issued by a server from an electronic marketplace, as required by claim 53.

For at least these reasons, the rejection of claim 53 is improper and should be withdrawn.

*Claim 54*

Claim 54 requires a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace. With respect to claim 54, the Examiner again relied on Collins claim 9. However, as discussed thoroughly above, the plain language of claim 9 states that the complaint handling computer program of Collins receives position data from the parties, not from a database of an electronic marketplace. Claim 9 has no teaching whatsoever that describes transaction data being electronically communicated from a database of a marketplace to a database of an online dispute resolution system. The only “database” mentioned in claim 9 is a database of the complaint handling system containing resolutions. In other words, the only database even mentioned in claim 9 is the database of the dispute resolution system itself, not a database of a marketplace at all. Thus claim 9 entirely void of any teaching of a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace, as required by claim 54.

*Claim 55*

Claim 55 requires wherein the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace. Claim 55 also requires that the rating data relates to participation of the buyers and sellers of the marketplace within the online dispute resolution process.

With respect to claim 55, the Examiner’s entire argument is a single statement that Figure 1B and [0045] of Collins describes a merchant database storing an associated rating of the customer. Again, this reasoning fails for at least four reasons.

First, as discussed above, this subject matter of Collins does not qualify as prior art.

Second, the “customer rating” described by Collins appears is a merchant’s rating of the customer (e.g., based on sales volume associated with that customer), and is not rating data relates to participation of the buyers and sellers of the marketplace within the online dispute

resolution process, as specifically required by claim 55. The Examiner has not even addressed these elements of Applicant's claims.

Third, the Examiner has not addressed the literal requirement of claim 55 that the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace. Collins describes the customer rating as maintained by the merchant database, and the Examiner's passing reference to the merchant database completely overlooks the literal requirements of Applicant's claim 55 that rating data is communicated from the online dispute resolution system to the marketplace. Contrary to claim 55, [0052] Collins describes the rating data as being stored at a merchant database and then communicated in the opposite direction, i.e., from the merchant database to the Collins' complaint handling system. Applicants' claim requires an online dispute resolution system having the novel ability to communicate rating data back to the electronic marketplace. To the extent the single merchant database can even be considered a marketplace, Collins does not teach or suggest communicating rating information from the online dispute resolution system to the online marketplace.

Fourth, as pointed out above, single merchant database of Figure 1B is not an electronic marketplace that stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services, as required by claim 55.

For at least these reasons, the rejection of claim 55 is improper and should be withdrawn.

#### *Claim 56*

Claim 56 specifically requires that the online dispute resolution system maintain the rating data based on compliance of the buyers and sellers to final decisions made in the resolution of the disputes. In rejecting claim 56, the Examiner refers only to the customer rating maintained by the merchant. The customer rating of Collins is a rating of the customer assigned by the merchant based on the "loyalty" of that customer to the merchant. This type of rating has nothing to do with an online dispute resolution system maintain the rating data based on *compliance* of the buyers and sellers to final decisions made in the resolution of the disputes, as required by claim 56. In fact, it appears that in Collins a customer of a merchant may have a

customer rating regardless of whether that customer has ever been involved in a dispute, let alone complied or failed to comply with a final decision.

For at least these reasons, the rejection of claim 56 is improper and should be withdrawn.

*Claim 57*

Claim 57 requires the electronic marketplace presents a web-based interface having embedded uniform resource locators that are associated with the dispute resolution system that enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and automatically initiate the filing of disputes relating to the transactions. Applicant can find no statement with the Office Action where the Examiner addressed these claim elements. For example, Applicant can find no statement by the Examiner addressing the requirement that the electronic marketplace presents a web-based interface having embedded uniform resource locators that are associated with the dispute resolution system. Similarly, Applicant can find no statement by the Examiner addressing the requirement that the embedded uniform resource locators of the electronic marketplace enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace. Further, Applicant can find no statement by the Examiner addressing the requirement that the embedded uniform resource locators of the electronic marketplace enable the users to automatically initiate the filing of disputes relating to the transactions. It appears that the Examiner has not even considered these limitations in view of the 35 USC 112 rejection addressed above. If this is the case, the rejection of claim 57 under 35 USC 102 is improper and should be withdrawn.



*Claim 61*

Claim 61 requires electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace. Thus, claim 61 requires that data is communicated *back to the electronic marketplace*. Claim 61 also requires updating *the electronic marketplace* based on the data received from the dispute resolution system.

With respect to claim 61, the Examiner referred to Collins at [0042] and stated that Collins describes Party A initiating negotiation by contacting central server 120 of the Collins complaint handling system and providing data to the server. Party B then sends position data over the network to that same central server. Thus, in summary, the Examiner's statements entirely describe the Parties A and B manually entering position data into the Collins complaint handling system. Applicant is left to wonder what this has to do with Applicant's claim language that the data is communicated *to the electronic marketplace*. The Examiner seems to have misread claim 61 to describe communicating data to the online dispute resolutions system.

The portions of Collins cited by the Examiner only describe Parties entering data in the Collins complaint handling system. Collins is entirely silent with respect to electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace. Even if the merchant database of Collins could somehow be constructed as marketplace for buyers and sellers, Collins does not describe any manner in which the Collins complaint handling system communicates data back to the merchant database.

Further, with respect to the rejection of claim 61 under 35 USC 102(e), the Examiner did not even comment on or address the limitations of updating the electronic marketplace based on the data received from the dispute resolution system.

For at least these reasons, the rejection of claim 61 is improper and should be withdrawn.

*Claim 64*

Claim 64 requires that the online dispute resolution system receives an electronic query from the marketplace and provides a status of a marketplace member of the marketplace in response to the query. Claim 65 requires receiving with the online dispute resolution system an electronic query from the electronic marketplace, and electronically providing a status associated with one of the users from a database of the online dispute resolution system to the database of the electronic marketplace in response to the query.

With respect to the rejection under 35 USC 102(e), the Examiner has failed to address any of these elements. In fact, the Examiner was entirely silent with respect to claim 64. With respect to claim 65, the Examiner cited the “eligibility status” described by Collins at [0047]. However, [0047] only describes the Collins complaint handling system as determining the eligibility of a party filing the complaint. If the party is not eligible, a “session is not established.” Thus, the “eligibility status” of Collins is not communicated from the Collins complaint handling system at all, certainly not to an electronic marketplace in response to a query received from the electronic marketplace, as required by claim 64.

In Collins, a complaint session is not established is a party is not “eligible.” Nowhere in the Office Action did the Examiner provide any evidence that Collins teaches or suggests an online dispute resolution system that receives an electronic query from an online marketplace, as required by claim 64. Moreover, nowhere in the Office Action did the Examiner provide any evidence that Collins teaches or suggests an online dispute resolution system that provides a status of a marketplace member of the marketplace in response to the query, as further required by claims 64 and 65.

The only other analysis provided by the Examiner that can be considered remotely relevant to claims 64 or 65 is the passing reference to the customer rating maintained by the merchant database of Collins. As discussed thoroughly above, this customer rating is maintained *at the merchant database* and, therefore, is certainly not *provided to* the merchant database by the Collins complaint handling system *in response to a query*. To the contrary, Collins states that the merchant database provides the customer rating to the complaint handling system. Thus, this description is clearly not referring to a status of a marketplace member as maintained by the online dispute resolution system, and is not referring to communicating that status back to the electronic marketplace in response to a query. No feature of the complaint handling system of Collins is described as being capable of servicing any form of query from another system, let alone an electronic marketplace.

#### *Claims 66 and 67*

Claim 66 requires a dispute resolution system electronically coupled to an electronic marketplace for buyers and sellers of goods and services. Claim 67 requires providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace stores transaction data that describes transactions within the marketplace. With respect to these elements, the Examiner refers primarily to Figure 1B and [0045] stating that Collins describes a merchant database maintaining records for customers and that the dispute may arise in connection over the Internet. As discussed above, this subject matter of Collins is not supported by any of the priority documents that predate Applicant's priority date and, therefore, this subject matter does not qualify as prior art. In addition to this error, Applicant points out that the single merchant database of Figure 1B is not an electronic marketplace that stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services, as required by claim 66. Applicant's claim 66 specifically requires that the claimed marketplace have both a plurality of "buyers" and a plurality of "sellers."

Applicant's claim 66 further requires a software application to automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system in response to a transaction within the electronic marketplace by a

member of the online dispute resolution system. Applicant's claim 67 requires automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute. With respect to these elements, the Examiner again refers to Collins at claim 9. However, Collins' claim 9 specifically recites a computer program product of the complaint handling system having program code for "receiving position data from each of the plurality of parties over the network." Thus, the plain language of claim 9 states that the computer program receives position data from the parties, not from a database of an electronic marketplace. Claim 9 of Collins has no teaching whatsoever that describes transaction data being electronically communicated from a database of a marketplace to a database of an online dispute resolution system. In fact, the only "database" mentioned in claim 9 of Collins is a "database containing resolutions." In other words, the only database even mentioned in claim 9 is the database of the dispute resolution system itself, not a database of a marketplace at all. Claim 9 of Collins entirely void of any teaching of automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system in response to a transaction within the electronic marketplace by a member of the online dispute resolution system, as required by claim 66. Claim 9 of Collins is similarly void of any teaching of automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute, as required by claim 67

For at least these reasons, the rejection of claims 66 and 67 is improper and should be withdrawn.

*Claims 68–72*

With respect to claims 68–72, the Examiner again relied on Figure 1B and portions of the related subject matter of Collins that does not qualify as prior art. For at least this reason, and in view of the other errors by the Examiner set forth above, the rejection of claims 68–72 should be withdrawn.

In order to support an anticipation rejection under 35 U.S.C. 102(b), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule

of law is commonly referred to as the “all-elements rule.”<sup>27</sup> If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(b) is improper.<sup>28</sup>

Collins fails to disclose each and every limitation set forth in claims 49–61 and 64–72. For at least these reasons, the Examiner has failed to establish a *prima facie* case for anticipation of Applicant’s claims 49–61 and 64–72 under 35 U.S.C. 102(e). Withdrawal of this rejection is requested.

### **Claim Rejection Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 62 and 63 under 35 U.S.C. 103(a) as being unpatentable over Collins. Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant’s claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

#### *Claim 62*

Applicant’s claim 62 requires displaying *in the electronic marketplace* visual indicia associated with users of the electronic marketplace that participate in the dispute resolution system. Claim 62 further requires controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.

In rejecting claim 62, the Examiner recognizes that Collins does not disclose any of the elements of Applicant’s claim 62. The Examiner then refers to a pull down box provided by screen of the Collins complaint handling system (as described in [0061] of Collins) to allow a party to select from a list of parties bound to participate in negotiations. The Examiner then asserts that it would be obvious to one of ordinary skill in the art to modify the pull down box to visual indicia to achieve Applicant’s claimed invention.

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<sup>27</sup> See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) (“it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention”).

<sup>28</sup> *Id.*; see also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

This reasoning is erroneous in view of the plain language of claim 61. First, Applicant's claim 61 requires displaying visual indicia *in the electronic marketplace*. In contrast, the pull down box cited by the Examiner is displayed by the Collins complaint handling system itself, not in a separate electronic marketplace. Second, claim 61 requires controlling the appearance of the visual indicia in that separate electronic marketplace as a function of data *received from the dispute resolution system*. The Examiner has provided no substantial evidence that it would be obvious in view of Collins to control the visual indication within an electronic marketplace based on data *received from the dispute resolution system*. Again, the pull down box referred to by the Examiner is displayed by the Collins complaint handling system itself. Previously, the Examiner argued that the merchant database of Figure 1b was somehow an electronic marketplace. Perhaps the Examiner overlooked the fact that Collins at [0061] is referring to the complaint handling system and not the merchant database. Otherwise, the Examiner appears to suggest that the Collins complaint handling system could be modified to control its own this pull-down box as a function of data received from itself.

In any event, modification of the pull down box of the Collins complaint handling system as suggested by the Examiner fails to achieve Applicant's claimed invention of displaying *in the electronic marketplace* visual indicia associated with users of the electronic marketplace that participate in the dispute resolution system. Similarly, the proposed modification fails to achieve Applicant's claimed invention of controlling the appearance of the visual indicia *in the marketplace* as a function of data received *from the dispute resolution system* for the users in response to resolution of the disputes.

### *Claim 63*

Claim 63 requires embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website of the electronic marketplace to enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and file disputes without manually entering the transaction data into the dispute resolution system.

With respect to claim 63, the Examiner takes “Official Notice” that it is old and well known to provide a URL within a website to access another system “as evidenced by Yahoo. [sic] Google, and the PTO website, all having hyperlinks to other sites.”

In this broad statement, the Examiner has grossly overlooked many of the elements of claim 63. For example, claim 63 requires embedding URLs within an electronic marketplace in a manner that enable users to file disputes. Although the Applicant cannot substantively comment on the URLs of which the Examiner is aware without her actually providing evidence in the record, it appears that she is referring to URLs that generally redirect a user from one site to another. None of the statements provided by the Examiner provide substantial evidence that it was known at the time of Applicant’s invention to embed URLs within an electronic marketplace in a manner that allows users of that marketplace to actually file disputes from the marketplace. Moreover, none of the statements provided by the Examiner provide substantial evidence that it was known at the time of Applicant’s invention to embed URLs within an electronic marketplace in a manner that allows users of that marketplace to file disputes without manually entering transaction data into the dispute resolution system.

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection.<sup>29</sup> Specifically, the Federal Circuit stated: “[the] factual question of motivation is material to patentability, and (can) not be resolved on subjective belief and unknown authority.<sup>30</sup> This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.<sup>31</sup> Deficiencies in the evidentiary record cannot be cured by general conclusions such as “general knowledge” or “common sense.”<sup>32</sup> Accordingly, the Examiner cannot rely on unsupported, conclusory statements to close holes in the evidentiary record.<sup>33</sup> Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant’s dependent claims, the claims should be allowed. The conclusion of obviousness advanced by the Examiner relies on teachings

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<sup>29</sup> *In re Lee*, 61 USPQ2d 1430, (CAFC 2002).

<sup>30</sup> *Id.* at 1434.

<sup>31</sup> *Id.*

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*

plucked directly from Applicants' own disclosure, rather than the prior art. Indeed, the Examiner cited no prior art teaching.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 62-62 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

**New Claims:**

Applicant has added claim 73 to the pending application. The applied references fail to disclose or suggest the inventions defined by Applicant's new claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed inventions. As one example, the reference fail to disclose or suggest an electronic marketplace system that includes: (i) a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers, (ii) a database that stores data, and (iii) a software object that communicates the data from the database to an online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system, as recited by claim 73. No new matter has been added by the new claims.

**CONCLUSION**

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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11/23/2005

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